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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,473	09/17/2003	Carey E. Garibay	BEAS-01454US7	4342
23910	7590	12/20/2006	EXAMINER	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			AGWUMEZIE, CHARLES C	
ART UNIT		PAPER NUMBER		
3621				
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/20/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,473	GARIBAY ET AL.
	Examiner Charlie C. Agwumezie	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-129 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/11/05; 09/17/03; 05/17/06
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Claims

1. Claims 1, 10, 87 are amended. Claims 1-129 are pending in this application per the response to office action filed on October 13, 2006.

### *Response to Arguments*

2. Applicant's arguments filed October 13, 2006 have been fully considered but they are not persuasive.

With respect to Claims 1, 10 and 87, Applicant argues that individually selectable licenses that can be upgraded or downgraded in a batch mode is not shown, suggested or given a motivation for in the cited prior art. That is the amended claim limitation "the multiple software licenses are individually selectable by the software user" is not disclosed or suggested by the references of record.

In response Examiner respectfully disagrees and submits that Aldis et al discloses that "the multiple software licenses are individually selectable by the software user." Aldis teaches that digital licenses can be distributed in the form of license packs (batch). A license pack contains one or more digital licenses. A license pack contains a set that identify each individual license (see 0070). License download service is responsible for creating the license packs ... from the license database. ... License packs is a collection of one or more digital licenses (e.g., of several different kinds, perhaps) for use by the user (0080; 0147; see figs. 8-10 and 20-24). In other words user create their own license packs. Accordingly Aldis et al does disclose the claim limitation

"the multiple software licenses are individually selectable by the software user" as recited in independent claims 1, 10, and 87. Thus independent claims 1, 10, and 87 are not patentable over Aldis et al.

As per claims 2-9, 11-18, and 88-95, Applicant argues are dependent upon claims 1, 10 and 87 and for that reason and because of the additional limitations are allowable.

In response, examiner respectfully disagrees and submits that dependent claims 2-9, 11-18 and 88-95 are neither allowable being dependent on claims 1, 10, and 87 nor for their own recited limitations.

With respect to claims 19, 29 and 96, Applicant argues that none of the cited prior arts discloses or suggests skipping an intermediate version in an upgrade or downgrade.

In response examiner agrees with Applicant's assertion that none of the references explicitly discloses skipping an intermediate version in an upgrade or downgrade. However, Horstmann discloses that the relicensing manager ...allowing a user to relicense a previously licensed version for free instead or pay an upgrade fee to upgrade to the most current version (col. 4, lines 25-40). Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to upgrade or downgrade by skipping an intermediate version in an upgrade or downgrade in order to obtain or acquire the most current version because the desire of every software/licensing user is to stay current with the latest innovations.

As per claims 20-28, 30-38, and 97-105, Applicant argues are dependent upon claims 19, 29 and 96 and for that reason and because of the additional limitations are allowable.

In response examiner respectfully disagrees and submits that dependent claims 20-28, 30-38 and 97-105 are neither allowable being dependent on claims 19, 29, and 96 nor for their own recited limitations.

With respect to claims 39, 53, and 106, Applicant argues that none of the prior arts discloses or suggests the claimed steps of selecting a license, obtaining a list of appropriate product versions for upgrade or downgrade of the license and selecting an appropriate product version.

In response examiner respectfully disagrees with Applicant's characterization of Aldis et al's invention. Aldis et al clearly allows a user to create its own license packs by individually selecting the type or kinds of licenses suitable for the products the user is using (0070; 0080; 0147). The licenses selected to be in a license pack may be of different kinds and types suitable for different products. How can a user select a license for which the user does not know which product the license is suitable for? Thus Aldis et al does disclose all the limitations as claimed.

As per claims 40-52, 54-66, and 107-119, Applicant argues are dependent upon claims 19, 29 and 96 and for that reason and because of the additional limitations are allowable.

In response examiner respectfully disagrees and submits that dependent claims 40-52, 54-66 and 107-119 are neither allowable being dependent on claims 39, 52, and 106 nor for their own recited limitations.

With respect to claims 67, 77, and 120, Applicant argues that the prior art does not describe or suggest downgrading a software license.

In response, Examiner respectfully disagrees with Applicant's characterization of Horstman. Horstmann does describe downgrade of software version as well as the associated licenses as described by these claims.

As per claims 68-76, 78-86 and 121-129, Applicant argues are dependent upon claims 67, 77 and 120 and for that reason and because of the additional limitations are allowable.

In response examiner respectfully disagrees and submits that dependent claims 68-76, 78-86, and 121-129 are neither allowable being dependent on claims 67, 77 and 120 nor for their own recited limitations. Thus for the reasons stated above and as shown in the rejections claims 1-29 are unpatentable over the references of record.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-17, 39-41, 43-50, 52-55, 57-64, 66-94, 106-108, 110-117, and 119-129, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143.

As per claim 1, 10, 39, 53, 67, 77, 87, 106, 120, Aldis et al discloses a method comprising:

maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121).

What Aldis et al does not explicitly teach is under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record.

Aldis et al however teaches that the digital license can be distributed in a license pack. A license pack is contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as disclosed by present invention (see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs").

Ross et al however discloses a method comprising: under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 10; col. 30-35)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record as taught by Ross et al in order to ensure availability of various product versions and user satisfaction.

As per claim 2, 11, 44, 58, 68, 78, 88, 111, 121, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

As per claims 3, 12, 45, 59, 69, 79, 89, 112, 122, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; "web browser or API").

As per claims 4, 13, 22, 32, 46, 60, 70, 80, 90, 99, 113, and 123, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

As per claims 5, 14, 47, 61, 71, 81, 91, 114, 124, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer

requesting activation code...").

As per claims 6, 15, 48, 62, 72, 82, 92, 115, 125, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

As per claims 7, 16, 49, 63, 73, 83, 93, 116, 126, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

As per claims 8, 17, 26, 36, 50, 64, 74, 84, 94, 103, 117, 127, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

As per claims 28, 38, 52, 66, 76, 86, 105, 119, 129, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

As per claims 40, 54, 107, Aldis et al further discloses the method, wherein the list is obtained from another source (fig. 7).

As per claims 41, 55, 108, Aldis et al further discloses the method, wherein the list is obtained from a license generation system (fig. 4).

As per claims 43, 57, and 110, Aldis et al further discloses the method, wherein the list is provided to the software user as a pull down list (0102).

As per claims 75, 85, 128, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

4. Claims 9, 18, 51, 65, 95, and 118, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 as applied to claims 1, 10, 39, 53, 67, 77, 87, and 106 above, and further in view of Horstmann U.S. Patent No. 6,009,401

As per claim 9, 18, 51, 65, 95, and 118, both Aldis et al and Ross et al failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

5. Claims 19-28, 29-38, and 96-105, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Horstmann U.S. Patent No. 6,009,401.

As per claims 19, 29, and 96, Aldis et al discloses a method comprising maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121).

under the control of a software user, upgrading or downgrading the software version for software license, the upgrade or downgrade selected from a list of possible upgrades or downgrades (0070; 0080; 0147)

What Aldis et al does not explicitly teach is wherein the user can select an upgrade or downgrade that skips an intermediate version.

Horstmann fails to explicitly discloses wherein the user can select an upgrade or downgrade that skips an intermediate version. However, Horstmann discloses that the relicensing manager ...allowing a user to relicense a previously licensed version for free instead or pay an upgrade fee to upgrade to the most current version (col. 4, lines 25-40).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the user can select an upgrade or downgrade that skips an intermediate

version in view of the teachings of Horstmann in order to stay current with the latest versions or innovations.

As per claims 20, 30 and 97, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

As per claims 21, 31 and 98, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; "web browser or API").

As per claims 22, and 99, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

As per claims 23, 33 and 100, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer requesting activation code...").

As per claims 24,, 34, and 101, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

As per claims 25, 35, and 102, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

As per claims 26, 36, and 103, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

As per claims 28, 38, and 105, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

As per claims 27, 37, and 104, Aldis et al failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

6. · Claims 42, 56, and 109, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1

in view of Ross et al U.S. patent No. 5,553,143 as applied to claims 39, 53, and 106 above, and further in view of Biddle U.s. Patent Application No. 2002/0107809 A1

As per claims 42, 56, and 109, both Aldis et al and Ross et al failed to explicitly disclose the method, wherein the list is transferred as an XML file.

Boddle et al discloses the method, wherein the list is transferred as an XML file (0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the list is transferred as an XML file as taught by Biddle et al in order to show the data type or language used.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art as applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

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Or faxed to:

**(571) 273-8300.** [Official communications; including After Final communications labeled "Box AF"].

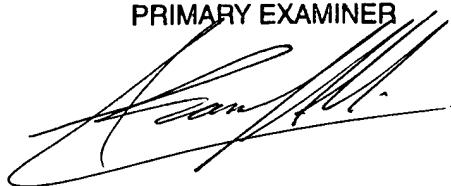
**(571) 273-8300.** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

Hand delivered responses should be brought to the United States Patent and Trademark Office Customer Service Window:

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**Charlie Lion Agwumezie  
Patent Examiner  
Art Unit 3621  
December 12, 2006**

**KAMBIZ ABDI  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Kambiz ABDI".